Attorney Docket No. 501247.00290 PATENT
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	)	
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Anthony G. Lutfallah	)	
	)	
Application No. 10/752,406	)	Examiner: Carlos Lugo
	)	
Confirmation No. 3878	)	Art Unit 3676
	)	
Filed January 6, 2004	)	
	)	
For: Universal Stop for a Slidable Window	)	

APPELLANT'S AMENDED APPEAL BRIEF

MAIL STOP APPEAL BRIEF - PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

This constitutes Applicant's brief on appeal. The information specified by 37 C.F.R. 41.37(c) is provided hereunder.

As an initial matter, the Examiner is thanked for the careful analysis that has been given to the claims of the present application and to the cited art. Nonetheless, the Examiner is mistaken in rejecting the claims of the present application. For the reasons that follow, the Examiner's rejections should be reversed.

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I. REAL PARTY IN INTEREST

The real party in interest is Newell Operating Company, the assignee.

II. RELATED APPEALS AND INTERFERENCES

There are no known related appeals or interferences.

III. STATUS OF CLAIMS

Twenty-nine (29) claims were originally filed in the application, and six (6) were added in prosecution. Claims 24, 30-33, 35, and 36 are pending for appeal. All pending claims have been rejected. A detailed status of the claims is as follows:

A. Claims originally filed: 1-29

B. Claims canceled: 1-23, 25-29, and 34

C. Claims added: 30-36

D. Claims currently pending: 24, 30-33, 35, and 36

E. Claims allowed: None

F. Claims rejected: 24, 30-33, 35, and 36

G. Claims objected to: None

H. Claims on appeal: 24, 30-33, 35, and 36

The independent claims in this application are 24, 30, 35, and 36. Each of the claims involved in this Appeal (24, 30-33, 35, and 36) are included in the attached Appendix.

IV. STATUS OF AMENDMENTS

An Amendment has been filed on January 8, 2007, pursuant to 37 C.F.R. §§ 1.116 and 41.33(a), after the date of filing the appeal and prior to the date of filing the present Appeal Brief. The claims are listed in the attached Appendix and discussed herein as amended by the Amendment.

V. SUMMARY OF THE CLAIMED SUBJECT MATTER

In making reference herein to various portions of the specification and drawings in order to explain the claimed invention (as required by 37 CFR §41.37(c)(1)(v)), Applicant does not intend to limit the claims. All references to the specification and drawings are illustrative unless otherwise explicitly stated.

The present application contemplates, in some embodiments, a window stop 10, such as for use with a sash window assembly as illustrated in FIG. 1. The sash window assembly 1 of FIG. 1 includes a master frame 2 having an upper sash window 3 and a lower sash window 4 slidably mounted therein. (P. 6, Ln. 7-13). Each sash window 3, 4 has a top rail 5, bottom rail 6 and a pair of vertical stiles 7. *Id.* Each stile 7 is typically hollow and includes a front wall or frame member 8. *Id.* In FIG. 1, a prior art window stop 11 is shown installed in the vertical stile 7 of the upper sash window 3, being mounted to the front wall 8 thereof. The window stop 10 can also be used in a horizontally sliding window assembly 9, such as that illustrated in FIG. 2, or for other similar assemblies, such as a sliding door assembly.

FIG. 3 shows a window stop 10 as disclosed in the application. The window stop 10 generally includes a housing 12, a bolt 14, an actuator 16, and a means for biasing the bolt 18, such as a spring 58. (P. 6, Ln. 20-28). The bolt 12 is moveable between a first or retracted position BP1 (FIG. 3), out of the path of window movement, and a second or extended position BP2 (FIG. 8), which places the bolt 12 into the path of window movement. *Id.* The actuator 16 is moveable between a first or locked position AP1 (FIG. 4), locking the bolt 14 in its first position BP1, and a second or released position AP2 (FIG. 7) that allows the bolt 14 to extend to its second position BP2. *Id.*

The housing 12 has a first projection 24 located on a bottom wall of the housing 12 that extends into the cavity 20. The first projection 24 has a pin 26 having a cam surface 27, which cooperates with the actuator 16 to hold the bolt 12 in the retracted position BP1. (Pg. 7, Ln. 12-15; FIG. 4). A faceplate or cover 32 is included with the housing 12, and is a solid member of

minimal thickness that is integral with the housing 12. The faceplate 32 extends beyond the remainder of the housing 12 to form a generally peripheral lip 49. (Pg. 8, Ln. 3-9; FIG. 4).

As shown in FIGS. 4 and 7, the actuator 16 is positioned within a recess 36 in the bolt 14, and is pivotally mounted therein. (P. 9, Ln. 9-19). The actuator 16 has a first leg 52 and a second leg 54 extending towards the bottom end 14b of the bolt 14. *Id.* The first leg 52 has a latch 56 having a cam surface 57. *Id.* The latch 56 is configured to cooperate with the pin 26 of the first projection 24 of the housing 12, as described below. *Id.* The second leg 54 is configured to bias the latch 56 against the pin 26 and thus bias the actuator 16 into its first position AP1. *Id.*

The window stop 10 is first configured as shown in FIGS. 3 and 4, where the bolt 14 is in its first position BP1, out of the path of sliding window movement of sash 4, and substantially flush with the faceplate 32. (P. 12, Ln. 16-29; FIG. 4). In this position, the actuator 16 is in its first position AP1 where the latch 56 on the actuator 16 is coupled to the pin 26 on the housing 12. *Id.* In this position, the actuator 16 holds the bolt 12 in its first position BP1 against the outward bias of the spring 58. *Id.* When it is desired to limit movement of the sliding window, the actuator 16 is operated by pivoting the actuator to its second position AP2 to allow the bolt 14 to extend to its second position BP2. (P. 12, Ln. 16-29; FIG. 7). As shown in FIG. 7, a person can manually rotate the actuator 16 clockwise, shown by the arrows A, to its second position AP2. *Id.* As the actuator 16 is pivoted to its second position AP2, the latch 56 disengages from the pin 26. (P. 13, Ln. 8-13; FIG. 7). As shown in FIGS. 8 and 9, the spring 58 then extends to immediately drive the bolt 14 out of the opening 22 to its second position BP2. (P. 13, Ln. 8-13). In this position, the bolt 14 is in the path of sliding window movement of the other or lower sash 4. *Id.*

When it is no longer desired to limit movement of the sliding window, the bolt 14 is returned to its first position BP1 by pushing the bolt back into the housing 12 through opening 22. (P. 14, Ln. 7-15; FIG. 7). As the bolt 14 is pushed into the housing against the outward bias 10 of the spring 58, the cam surface 57 of the actuator latch 56 engages the cam surface 27 of the

pin 26 on the first projection 24. *Id.* These surfaces cooperatively engage to pivot the actuator 16 towards is second position AP2. *Id.* As the bolt 14 is pushed further into the housing 12, the latch 56 passes the pin 26. (P. 14, Ln. 7-15; FIG. 4). The second leg 54 of the actuator 16 then biases the actuator 16 to its first position AP1 where the latch 56 engages the pin 26 and locks the bolt 14 in its first position BP1. *Id.*

To retain the housing 12 within a track 13 or stile of a window frame, the housing 12 has a pair of integrally formed resilient clips or tabs 34 located on opposite exterior or end walls 15 of the housing 12. The clips or tabs 34 include a base portion 39 at one end, which is mounted to or integral with an end wall 15 of the housing. The tabs 34 also have an engagement surface 45 distal from the base portion 39 and spaced from and generally opposed to the lip 49 of the cover 32. (P. 8, Ln. 10-26; FIG. 4).

The engagement surfaces 45 of the housing 12 of the present invention are inclined with respect to the lip 49 and face generally away from their respective end walls 13. (P. 16, Ln. 8-26; FIG. 4). Additionally, each inclined engagement surface 45 comprises a first, second and third ridge 78, 80 and 82, each of which being located successively further away from the lip 49 than its predecessor. *Id.* That is, the second ridge 80 is slightly further from the lip 49 than is the first ridge 78, and the third ridge 82 is slightly further from the lip 49 than is the second ridge 80. *Id.* Disposed among and/or between the ridges 78, 80, 82 are a first confronting surface 77, second confronting surface 79, and third confronting surface 81. *Id.* The arrangement of the lip 49, ridges 78, 80, 82 and confronting surfaces 77, 79, 81 permits the housing 12 to be installed in a wall 8 having a thickness within a range of varying thickness from a minimum to a maximum thickness. (P. 16, Ln. 8-26; FIGS. 12-15). The engagement surfaces 45 are in confronting and spaced relation to the cover of the housing 12. (P. 16, Ln. 8-26; FIG. 4). The variable engagement surfaces 45 cooperate with the cover of the housing 12 to receive walls 8 of frame members having variable thicknesses. (P. 16, Ln. 8-26; FIGS. 12-15).

To install the stop 10 of the present invention in a stile 7, the housing 12 is inserted into an aperture 72 in the stile 7. (FIGS. 12-15). As the housing 12 moves into the aperture 72, the

wall 8 forces the tabs 34 to flex inwards towards the end walls 13. (P. 17, Ln. 1-8). As the engagement surface 45 begins to pass by an inside aperture edge 74, the tabs 34 begin to return towards their un-flexed position. *Id.* FIG. 12 shows the housing 12 installed in a wall 8 of a particular thickness t1 such that the wall is generally received and held between the lip 49 and the first ridge 78. *Id.* In the wall 8 of FIG. 12, the first confronting surface 77 generally opposes or confronts the inner surface 76 of the wall 8. *Id.* FIG. 13 shows the housing 12 installed in a wall 8 having a thickness t2 greater than that shown in FIG. 12. (P. 17, Ln. 9-19). The wall 8 of FIG. 13 is generally received between the lip 49 and the second ridge 80 of the inclined engagement surface 45 of the tab 34, and the second confronting surface 79 generally confronts or opposes the inner surface 76 of the wall 8. *Id.* FIG. 14 shows the housing 12 installed in a wall 8 having a thickness slightly greater than that shown in FIG. 13. (P. 17, Ln. 20-28). The wall 8 of FIG. 14 is generally received between the lip 49 and the third ridge 82 of the inclined engagement surface 45 of the tab 34, and the third confronting surface opposes and/or generally confronts the inner surface 76 of the wall 8. *Id.*

FIG. 15 shows a housing 12 having tabs 234 having an alternative, substantially smooth, inclined engagement surface 245 with no ridges. (P. 18, Ln. 12-19). This inclined, planar engagement surface 245 extends from an inner edge 246 of the tab 234 proximal to the housing 12 to an outer edge 247 of the tab 234 distal from the housing 12. (P. 18, Ln. 12-15; FIG. 15). The inclined engagement surfaces 245 generally face away from their respective end walls 113. *Id.* The mount structure in FIG. 15 is adapted to receive any wall 8 having a thickness chosen from a plurality of walls 8 between a minimum thickness and a maximum thickness. (P. 18, Ln. 20-28). For thicknesses between the minimum and maximum thickness, the inside aperture edge 74 would engage the inclined engagement surface 245 somewhere generally between the inner edge 246 and the outer edge 247 of the engagement surface 245. *Id.*

The claims are directed to a window stop having one or more of the features described above, such as for use in a window assembly.

A. Claim 24

Claim 24 is directed toward a window stop for use in a window assembly having an upper sash and a lower sash, each sash slidably mounted in a master frame, as described above. The window stop 10 includes a housing 12 defining a cavity 20, and the housing has a cover 32 defining a lip 49. (P. 7, Ln. 5-7; P. 8, Ln. 3-9; FIG. 4). The housing also has a tab 34 having an inclined engagement surface 45 in spaced relation to the lip. (P. 16, Ln. 8-16; FIG. 4). The engagement surface has a plurality of ridges 78, 80, 82, at least one of which is inclined away from the lip. (P. 16, Ln. 8-16; FIG. 4). The engagement surface and the lip are adapted to cooperatively engage a frame member 8, which can be any of a plurality of frame members having a thickness between a minimum thickness and a maximum thickness. (P. 16, Ln. 16-26; FIGS. 12-15). The housing also has a projection 24 extending into the cavity. (P. 7, Ln. 12-14). A bolt 14 is operably mounted within the cavity and is moveable between a retracted position BP1 and an extended position BP2. (P. 6, Ln. 24-28). In the retracted position, the bolt is substantially located within the housing and is thereby out of the path of movement of the lower sash. (P.12, Ln. 17-23; FIGS. 3-4). In the extended position, the bolt extends from within the cavity and into the path of movement of the lower sash. (P. 12, Ln. 24-27; FIGS. 8-9). The stop includes a means 18 for biasing the bolt toward the extended position. (P. 7, Ln. 7; FIG. 3). An actuator 16 is pivotally mounted to the bolt, and has a hook 56 at one end for engaging the projection to retain the bolt in the retracted position when the actuator is in the locked position AP1. (P. 12, Ln. 17-23; FIG. 4). The actuator is pivotable from the locked position to a release position AP2, where the hook disengages from the projection to permit the bolt to move toward the extended position. (P. 12, Ln. 24-27; FIGS. 8-9).

B. Claim 30

Claim 30, and the claims depending therefrom, are directed toward a window stop. The window stop 10 includes a housing 12 defining a cavity 20, and the housing has an end wall 15 and a cover 32 defining a lip 49. (P. 7, Ln. 5-7; P. 8, Ln. 3-9; FIG. 4). The housing has a tab 34 having a base portion 39 mounted to the end wall and extending away from the end wall. (P. 8,

Ln. 12-13). The tab has a planar engagement surface 45, 245, which is distal from the base portion and is spaced from the lip and inclined with respect to the lip. (P. 16, Ln. 8-16; P. 18, Ln. 12-15; FIGS. 4 and 15). A bolt 14 is mounted within the cavity and is moveable between a retracted position BP1 and a locking position BP2. (P. 6, Ln. 24-28). In the retracted position, the bolt is substantially located within the housing, and in the locking position, the bolt extends from the cavity. (P.12, Ln. 17-27; FIGS. 3 and 9).

C. Claim 35

Claim 35 is directed toward a window stop. The window stop 10 includes a housing 12 defining a cavity 20, and the housing has an end wall 15 and a cover 32 defining a lip 49. (P. 7, Ln. 5-7; P. 8, Ln. 3-9; FIG. 4). The housing has a tab 34 having a base portion 39 mounted to the end wall and extending away from the end wall. (P. 8, Ln. 12-13). The tab has a planar engagement surface 245, which is distal from the base portion and is spaced from the lip and inclined with respect to the lip. (P. 18, Ln. 12-15; FIG. 15). The planar engagement surface extends from an inner edge 246 of the tab proximal to the housing to an outer edge 247 of the tab distal from the housing. (P. 18, Ln. 12-15; FIG. 15). A bolt 14 is mounted within the cavity and is moveable between a retracted position BP1 and a locking position BP2. (P. 6, Ln. 24-28). In the retracted position, the bolt is substantially located within the housing, and in the locking position, the bolt extends from the cavity. (P.12, Ln. 17-27; FIGS. 3 and 9).

D. Claim 36

Claim 36 is directed toward a window stop for use in a window assembly having an upper sash and a lower sash, each sash slidably mounted in a master frame, as described above. The window stop 10 includes a housing 12 defining a cavity 20, and the housing has a cover 32 defining a lip 49. (P. 7, Ln. 5-7; P. 8, Ln. 3-9; FIG. 4). The housing also has a tab 34 having an inclined engagement surface 45 in spaced relation to the lip. (P. 16, Ln. 8-16; FIG. 4). The engagement surface has a plurality of ridges 78, 80, 82. (P. 16, Ln. 8-16; FIG. 4). The engagement surface and the lip are adapted to cooperatively engage a frame member 8, which can be any of a plurality of frame members having a thickness between a minimum thickness and

a maximum thickness. (P. 16, Ln. 16-26; FIGS. 12-14). The housing also has a projection 24 extending into the cavity. (P. 7, Ln. 12-14). A bolt 14 is operably mounted within the cavity and is moveable between a retracted position BP1 and an extended position BP2. (P. 6, Ln. 24-28). In the retracted position, the bolt is substantially located within the housing and is thereby out of the path of movement of the lower sash. (P.12, Ln. 17-23; FIGS. 3-4). In the extended position, the bolt extends from within the cavity and into the path of movement of the lower sash. (P. 12, Ln. 24-27; FIGS. 8-9). The stop includes a means 18 for biasing the bolt toward the extended position. (P. 7, Ln. 7; FIG. 3). An actuator 16 is pivotally mounted to the bolt, and has a hook 56 at one end for engaging the projection to retain the bolt in the retracted position when the actuator is in the locked position AP1. (P. 12, Ln. 17-23; FIG. 4). The actuator is pivotable from the locked position to a release position AP2, where the hook disengages from the projection to permit the bolt to move toward the extended position. (P. 12, Ln. 24-27; FIGS. 8-9).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The following grounds of rejection are to be reviewed on appeal:

1. Whether claims 24, 30-33, and 35 were properly rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,806,900 to Bratcher *et al.* ("Bratcher") in view of U.S. Patent No. 6,575,681 to Kojima *et al.* ("Kojima").
2. Whether claim 36 was properly rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,806,900 to Bratcher *et al.* ("Bratcher") in view of U.S. Patent No. 6,250,694 to Weiland ("Weiland").

VII. ARGUMENTS

A. The Standard of Law For a Section 103 Rejection

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art reference(s) must teach or suggest all of the claim limitations. The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. *See* MPEP §2142; *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Appellant submits that, because no *prima facie* case of obviousness has been established, the inventions of claims 24, 30-33, 35, and 36 are not obvious in view of the cited references.

B. Kojima is Non-Analogous Art and Not Properly Combinable With Bratcher – Applicable to All Claims

In the Final Office Action, the Examiner rejected claims 24, 30-33, and 35 under 35 U.S.C. § 103(a) as being unpatentable over Bratcher in view of Kojima. Appellant submits that the Examiner has not established a *prima facie* case of obviousness with respect to claims 24, 30-33, and 35 on the basis that Kojima is non-analogous art, and thus, Bratcher and Kojima are not properly combinable to form an obviousness rejection.

Kojima deals with a completely separate and non-analogous art relative to the present application, as well as to Bratcher. A prior art reference is analogous if the reference is in the field of applicant's endeavor or, if not, the reference is reasonably pertinent to the particular problem with which the invention was concerned. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443 (Fed. Cir. 1992). The present application discloses and claims a window stop. Bratcher also discloses a window stop, for liming movement of a sliding window. (Bratcher, Col. 2, Ln. 8-10). Kojima, however, discloses a resin clip designed to be fitted into an attachment hole in a panel for an automobile. (Kojima, Col. 1, Ln. 6-8). Thus, Kojima is clearly

not in the field of the applicant's endeavor here. Appellant also submits that Kojima is not reasonably pertinent to the particular problem with which the present invention is concerned.

One relevant problem solved by the window stop disclosed in the present application deals with insertion of a moveable window stop into an elongated opening in a window frame having a variable thickness. Kojima deals with insertion of a stationary clip for holding a hose or wire harness into a circular hole in a panel for an automobile. There is no suggestion or disclosure in Kojima to use the disclosed clip in connection with a window assembly, not even an automobile window assembly. One skilled in the art of windows and window stops could not reasonably be expected to look to automobile panels and clips therefor to solve such a problem.

Additionally, the clip of Kojima is not designed, disclosed, or contemplated to operate with moving parts. The moveable bolt 14 of the window stop 10 in the present application is essential to its operation, because it permits the window stop to selectively obstruct movement of the sliding window. For obviousness purposes, prior art references are to be viewed as a whole (*W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 303 (Fed. Cir. 1983)), and Examiners should not pick and choose from the disclosures of the prior art. When the disclosure of Kojima is viewed as a whole, one skilled in the art of windows and window stops would not look to it for potential modifications when designing a window stop, because the clip of Kojima is not disclosed or even suggested to be used in conjunction with moving parts.

Further, the present application is directed to securing the window stop 10 in a wall 8 of a window assembly in a clamping arrangement between an engagement surface 45 and a lip 49 in confronting relation. (See FIGS. 12-15). Kojima does disclose engagement of a panel from below by stepped locking parts (41) and from above by a flange (20) (See Kojima, FIGS. 7A-7C). However, the flange (20) and locking parts (41) are not close to confronting, and Kojima's arrangement of the flange (20) and locking parts (41) would not work in a window stop, since the flange (20) would obstruct movement of the window. Again, when viewed as a whole, one skilled in the art would not look to the disclosure of Kojima when designing a window stop.

Thus, Bratcher and Kojima are not properly combinable to form an obviousness rejection, and the Examiner's rejection of claim 24 over the combination of Bratcher and Kojima is improper.

Appellant notes that claim 36 has never been rejected over the combination of Bratcher and Kojima. However, the Examiner cannot properly assert that claim 36 is unpatentable over the combination of Bratcher and Kojima as applied to claim 24 above, for the same reasons articulated with respect to claims 24, 30-33, and 35.

C. Bratcher and Kojima Are Not Properly Combinable Because There Is No Motivation To Combine The Teachings Of The References – Applicable to All Claims

Appellant submits that the Examiner has not established a *prima facie* case of obviousness with respect to claims 24, 30-33, and 35 on the basis that Bratcher and Kojima are not properly combinable to form an obviousness rejection because there is no motivation to combine the teachings of the cited references.

1. The Examiner Has Engaged In Improper Hindsight Reconstruction

As a first matter, the Examiner's rejections constitute a classic case of improper hindsight reconstruction. Virtually all inventions are combinations of old elements. Therefore, an Examiner may often find every element of a claimed invention in prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an Examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat patentability of the claimed invention. To counter this potential weakness in the obviousness construct, the suggestion to combine requirement stands as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness. *Yamanouchi Pharmaceutical Co. v. Danbury Pharmacal Inc.*, 231 F.3d 1339, 56 U.S.P.Q.2d 1641, 1644 (Fed. Cir. 2000).

Appellant respectfully submits that the Examiner could only have arrived at a conclusion of obviousness through hindsight analysis by reading Appellant's own inventive teaching in the art and by attempting to select those elements from the cited references. Bratcher provides no suggestion of any need to modify the clips (34) to adapt to window frames having different thicknesses. The Examiner has cited no other reference prior to the disclosure of the present application to suggest that a window stop, such as that of Bratcher, could or should be modified to adapt to window frames having different thicknesses. Since the Examiner has provided no such motivation, the Examiner has used the applicant's disclosure as a template, rather than focusing on the knowledge and motivation available to those skilled in the art at the time of invention, thereby engaging in improper hindsight analysis. *See In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988) ("one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention"). Such decomposition of an invention "into its constituent elements, finding each element in the prior art, and then claiming that it is easy to reassemble these elements into the invention, is a forbidden *ex post* analysis." *In re Mahurkar Patent Litigation*, 831 F.Supp. 1354, 1374, 28 U.S.P.Q.2d 1801, 1817 (N.D. Ill. 1993).

Additionally, the Federal Circuit has warned against distilling an invention down to the "gist" or "thrust" of an invention, as such an approach disregards the requirement of analyzing the subject matter "as a whole." *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 303 (Fed. Cir. 1983). The present invention cannot simply be boiled down to "adding stepped or variable surfaces to an existing window stop." However, that is precisely what the Examiner has done by simply "picking and choosing" the stepped surface from the disclosure of Kojima to be incorporated into a window stop. The fact that the Examiner ignores the context of Kojima's disclosure (*i.e.*, the fact that Kojima is a clip designed for automotive use and without regard to any moving parts, as described above) is a clear mark of the Examiner's improper hindsight reconstruction.

The Examiner asserts that "a conclusion of obviousness may be made from common knowledge and common sense of the person of ordinary skill without any specific hint or suggestion in a particular reference." (Final Rejection, P. 3). While this may be true, Appellant responds that the Examiner's failure to identify a motivation explicit or implicit in the prior art of record is indicative of the Examiner's use of hindsight, and resorting to "common knowledge" as the basis for this motivation is merely pretext.

2. Kojima and Bratcher Provide No Motivation To Combine

Appellants submit that the Kojima provides no motivation to use its disclosure to modify a window stop, such as that disclosed by Bratcher, and Bratcher also provides no such motivation.

First, the features of the resin clip of Kojima would require significant modification to be incorporated into a window stop. The resin clip of Kojima is configured for insertion into a circular opening (See Kojima, FIG. 1), not an elongated opening, into which a window stop is typically inserted. (See Bratcher, FIG. 1). Additionally, the flange (20) of Kojima is inclined downward, in contrast to the lip of a window stop, which is typically parallel to the surface on which it rests. (See Bratcher, FIGS. 7-8). Thus, because Kojima provides no motivation or suggestion to arrange the flange (20) and the stepped locking parts (41) in any particular inclined arrangement to each other, the Examiner can only speculate what type of window stop would result from the combination of Bratcher and Kojima.

Additionally, all of the claims at issue recite that the engagement surface is inclined with respect to the lip, but Kojima does not discuss any advantages to such an arrangement. Kojima does disclose having a stepped configuration of the locking parts (41), and, in the embodiment shown in FIGS. 6-7C, the locking parts (41) appear to be angled downward. However, Kojima does not disclose even one advantage to configuring the locking parts (41) in any type of angled or inclined arrangement with respect to the flange (20). Thus, even if one skilled in the art would be motivated to look outside the relevant art to Kojima to develop a window stop for insertion

into a frame of varying thickness, Kojima provides no motivation or suggestion to utilize an engagement surface that is inclined with respect to the lip thereof.

Bratcher provides no motivation to modify its disclosed structure as recited in the present claims, and the Examiner identifies no such motivation.

Thus, Bratcher and Kojima are not properly combinable to form an obviousness rejection, and the Examiner's rejection of claims 24, 30-33, and 35 over the combination of Bratcher and Kojima is improper.

Appellant notes that claim 36 has never been rejected over the combination of Bratcher and Kojima. However, the Examiner cannot properly assert that claim 36 is unpatentable over the combination of Bratcher and Kojima as applied to claim 24 above, for the same reasons articulated with respect to claims 24, 30-33, and 35.

D. Bratcher and Kojima Do Not Disclose A Planar Engagement Surface Extending From An Inner Edge To An Outer Edge – Applicable to Claim 35

Appellant submits that the Examiner has not established a *prima facie* case of obviousness with respect to claim 35, because the proposed combination of Bratcher and Kojima does not disclose, teach, or suggest all the elements of claim 35.

Claim 35 includes, among other elements, "a tab ... having a planar engagement surface distal from the base portion, the planar engagement surface being spaced from the lip and inclined with respect to the lip, the planar engagement surface extending from an inner edge of the tab proximal to the housing to an outer edge of the tab distal from the housing." As shown in FIG. 15 of the present Application, the planar engagement surface 245 is disclosed as an inclined planar engagement surface that extends from an inner edge 246 of the tab proximal to the housing to an outer edge 247 of the tab distal from the housing. The Examiner acknowledges, in paragraph 3 of the Office Action, and in the previous Office Action, that Bratcher does not disclose, teach, or suggest this element of claim 35. Kojima also does not disclose, teach, or suggest this element of claim 35.

Kojima discloses a resin clip (10) designed to be fitted into an attachment hole in a panel for an automobile. The resin clip (10) has a skirt-like flange (20), a pillar (30) depending from the flange (20), and a pair of elastic legs (40) extending from the bottom of the pillar (30) back toward the flange (20), each leg (40) having several stepped locking parts (41a, 41b, 41c) at the tip thereof. (Kojima, Col. 3, Lines 52-59; Col. 4, Lines 51-53). Kojima does not disclose a tab having a planar engagement surface "extending from an inner edge of the tab proximal to the housing to an outer edge of the tab distal from the housing." Rather, the resin clip (10) of Kojima has a stepped engagement surface containing several stepped locking parts (41), rather than a single engagement surface that extends from an inner edge to an outer edge of the tab. Furthermore, Kojima does not suggest modifying the stepped locking parts to a single planar engagement surface. Thus, neither Bratcher nor Kojima discloses, teaches, or suggests this element of claim 35, and the Examiner's rejection of claim 35 over the combination of Bratcher and Kojima is improper.

E. Bratcher and Weiland Are Not Properly Combinable Because There Is No Motivation To Combine The Teachings Of The References – Applicable to Claim 36

Claim 36 is identical to claim 24 as originally filed. In the Office Action dated March 23, 2005, the Examiner rejected claim 36 (original claim 24) under 35 U.S.C. § 103(a) as being unpatentable over Bratcher in view of Weiland. Appellant submits that the Examiner has not established a *prima facie* case of obviousness with respect to claim 36 basis that Bratcher and Weiland are not properly combinable to form an obviousness rejection because there is no motivation for one skilled in the art to make the proposed combination.

Once again, the Examiner's previous rejection over Bratcher and Weiland constituted a classic case of improper hindsight reconstruction. Bratcher provides no suggestion of any need to modify the clips (34) to adapt to window frames having different thicknesses. The Examiner has cited no other reference prior to the disclosure of the present application to suggest that a window stop, such as that of Bratcher, could or should be modified to adapt to window frames

having different thicknesses. While Weiland does disclose snap legs with ends having ridges (46), there is no disclosure anywhere in Weiland regarding the use of the disclosed device in frames having different thicknesses. The ridged snap legs themselves are only briefly mentioned in Weiland. In fact, a generous reading of the Detailed Description of Weiland reveals, at most, seven lines of text related in any way to the ridged snap legs (Weiland, Col. 4, Ln. 31-32; Col. 5, Ln. 28-32), and only one minor dependent claim related thereto (Weiland, Claim 4). Rather, the disclosure of Weiland is directed to the latching structure, and the alleged simplicity, quietness, and ease of assembly it provides. (See, *e.g.*, Weiland, Col. 1, Ln. 10-13). Thus, one skilled in the art would not look to Weiland for modifications to a mounting structure, because the disclosure of Weiland is not directed to such problems.

Since the Examiner has provided no motivation to modify the clips of Bratcher to adapt to window frames having different thicknesses, the Examiner has used the applicant's disclosure as a template, rather than focusing on the knowledge and motivation available to those skilled in the art at the time of invention, thereby engaging in improper hindsight analysis. *See In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988) ("one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention"). Again, the Examiner has simply boiled the present invention down to "adding stepped or variable surfaces to an existing window stop," by simply picking and choosing the stepped surface from the disclosure of Weiland to be incorporated into a window stop. The Examiner ignores the lack of any explicit or implicit motivation in the prior art for combining the disclosures of Bratcher and Weiland, which is a clear mark of the Examiner's improper hindsight reconstruction.

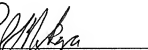
Thus, Bratcher and Weiland are not properly combinable to form an obviousness rejection of claim 36, and the Board is respectfully requested to pass claim 36 to issue.

VIII. CONCLUSION

For the foregoing reasons, Appellant respectfully requests that the Board reverse the Examiner's rejections, and order that claims 24, 30-33, 35, and 36 be passed to issue.

Respectfully submitted,

Date: January 9, 2007

By: 

Paul J. Nykaza, Registration No. 38,984
BANNER & WITCOFF, LTD.
10 South Wacker Drive - 3000
Chicago, IL 60606
Telephone: 1-312-463-5000

CLAIMS APPENDIX

1-23. (Canceled)

24. (Previously Presented) A window stop for use in a window assembly having an upper sash and a lower sash, each sash slidably mounted in a master frame, each sash having a top rail a bottom rail and a pair of vertical stiles, each vertical stile having a front wall, the window stop comprising:

a housing defining a cavity, the housing having a cover defining a lip, the housing further having a tab having an inclined engagement surface in spaced relation to the lip, the engagement surface comprising a plurality of ridges, at least one of which is inclined away from the lip, wherein the engagement surface and lip are adapted to cooperatively engage the frame member, the frame member being any of a plurality of frame members having a thickness between a minimum thickness and a maximum thickness, the housing further having a projection extending into the cavity;

a bolt operably mounted within the cavity and moveable between a retracted position wherein the bolt is substantially located within the housing and thereby out of a path of movement of the lower sash and an extended position wherein the bolt extends from within the cavity and into the path of movement of the lower sash;

means for biasing the bolt towards the extended position, and

an actuator pivotally mounted to the bolt having a hook at one end for engaging the projection to retain the bolt in the retracted position when the actuator is in a locked position, the actuator pivotable from the locked position to a release position wherein the hook disengages from the projection to permit the bolt to move towards the extended position.

25-29. (Canceled)

30. (Previously Presented) A window stop comprising:

a housing defining a cavity, the housing having an end wall and a cover defining a lip;

a tab having a base portion mounted to the end wall and extending away from the end wall, the tab having a planar engagement surface distal from the base portion, the planar engagement surface being spaced from the lip and inclined with respect to the lip; and

a bolt mounted within the cavity and moveable between a retracted position wherein the bolt is substantially located within the housing and a locking position wherein the bolt extends from the cavity.

31. (Previously Presented) The window stop of claim 30 wherein the engagement surface is spaced from the end wall.

32. (Previously Presented) The window stop of claim 30 wherein a distal end of the tab is spaced from the end wall when the tab is in an unflexed position.

33. (Previously Presented) The window stop of claim 30 wherein the engagement surface is substantially smooth.

34. (Cancelled)

35. (Previously Presented) A window stop comprising:

a housing defining a cavity, the housing having an end wall and a cover defining a lip;

a tab having a base portion mounted to the end wall and extending away from the end wall, the tab having a planar engagement surface distal from the base portion, the planar engagement surface being spaced from the lip and inclined with respect to the lip, the planar engagement surface extending from an inner edge of the tab proximal to the housing to an outer edge of the tab distal from the housing; and

a bolt mounted within the cavity and moveable between a retracted position wherein the bolt is substantially located within the housing and a locking position wherein the bolt extends from the cavity.

36. (New – Original Claim 24) A widow stop for use in a window assembly having an upper sash and a lower sash, each sash slidably mounted in a master frame, each sash having a top rail a bottom rail and a pair of vertical stiles, each vertical stile having a front wall, the window stop comprising:

a housing defining a cavity, the housing having a cover defining a lip, the housing further having a tab having an inclined engagement surface in spaced relation to the lip, the engagement surface comprising a plurality of ridges, wherein the engagement surface and lip are adapted to cooperatively engage the frame member, the frame member being any of a plurality of frame members having a thickness between a minimum thickness and a maximum thickness, the housing further having a projection extending into the cavity;

a bolt operably mounted within the cavity and moveable between a retracted position wherein the bolt is substantially located within the housing and thereby out of a path of movement of the lower sash and an extended position wherein the bolt extends from within the cavity and into the path of movement of the lower sash;

means for biasing the bolt towards the extended position, and

an actuator pivotally mounted to the bolt having a hook at one end for engaging the projection to retain the bolt in the retracted position when the actuator is in a locked position, the actuator pivotable from the locked position to a release position wherein the hook disengages from the projection to permit the bolt to move towards the extended position.

EVIDENCE APPENDIX

None.

RELATED PROCEEDINGS APPENDIX

There are no known related appeals or interferences.